

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicants:	James Q. Mi, et al.	§	Art Unit:	2137
		§		
Serial No.:	09/259,620	§	Examiner:	Paul E. Callahan
		§		
Filed:	February 26, 1999	§	Assignee:	Intel Corporation
		§		
Title:	Computer System	§	Docket No.	ITL.0160US
	Identification	§		(P6668)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

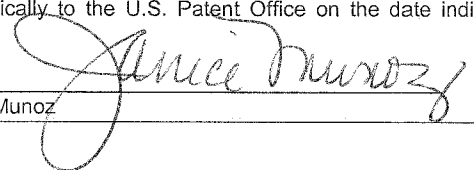
Dear Sir:

Applicant seeks pre-appeal review of the rejections of claims 39-50 and 52. In a Final Office Action mailed on September 2, 2009, claims 39, 41-43, 45-47, 49, 50 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claus, England and Duda; and claims 40, 44 and 48 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Claus, England and Lee.

To make a determination under 35 U.S.C. § 103, several basic factual inquiries must be performed, including determining the scope and content of the prior art, and ascertaining the differences between the prior art and the claims at issue. *Graham v. John Deere Co.*, 383 U.S. 1, 17, 148 U.S.P.Q. 459 (1965). Moreover, as the U.S. Supreme Court held, it is important to identify a reason that would have prompted a person of ordinary skill in the art to combine reference teachings in the manner that the claimed invention does. *KSR International Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1741, 82 U.S.P.Q.2d 1385 (2007).

Date of Deposit: September 30, 2009

I hereby certify that this correspondence is being transmitted electronically to the U.S. Patent Office on the date indicated above.


Janice Munoz

Applicant respectfully submits that the § 103 rejection of independent claim 39 is deficient for at least the reason that the Office Action fails to provide a plausible reason to explain why one of skill in the art in possession of Claus, England and Duda would have derived limitations of this claim. More specifically, in the Final Office Action, the Examiner relies on Duda for the teaching of, "an initial unsolicited request for authentication." Final Office Action, p. 2. To place the Duda reference in the appropriate context, Duda is directed to preventing someone from using multiple unsolicited authentication messages for purposes of decoding keys that are stored in a cellular telephone base station. More specifically, Duda describes tracking unexpected authentication messages in a network base station. Duda explains that by sending unexpected authentication messages, a user may, upon receipt of a number of messages, be able to decode an authentication key. By tracking the number of unexpected authentication messages, Duda purportedly adds a layer of security, as explained in Duda, 4:33-65 in column 4, in that new keys are installed after a predetermined number of unexpected messages are received at the base station.

The Office Action fails to explain why one of skill in the art in possession of Claus, England and Duda would have combined Duda with England and Claus to derive the claimed invention. More specifically, as Duda's security scheme is directed at preventing users from accessing keys that are stored in its network base station, one of skill in the art may have hypothetically applied Duda's security scheme to Claus' host system. However, this modification does not produce the claimed invention, as the § 103 rejection is relying on the modification of Claus' smart card and not the modification of its host system. As such, even assuming, for purposes of argument, that Duda may be hypothetically combined with Claus and England, one of skill in the art would still not have derived the claimed invention.

It is noted that no reason exists to incorporate any of Duda's system in Claus' smart card, in that the user of the smart card due to the very nature of the smart card controls when the ID is transmitted and therefore, controls when a challenge number (the purported "request") is received. There is no reason why the smart card would expect multiple unsolicited challenge numbers in that the smart card executes a predetermined algorithm of first transmitting the ID and then receiving a challenge number. Unexpected challenge numbers, however, would not be received or processed. Thus, there are no additional advantages that may be achieved in incorporating Duda's security algorithm into Claus' smart card or modifying Claus' smart card, in

general, to provide a visual interface or provide a hash value in response to such a request. As such, there has been no plausible explanation given to explain why one of skill in the art in possession of Claus, England and Duda would have combined these references to derive the claimed invention.

In the Final Office Action, the Examiner contends that the purported motivation to allow an unsolicited request for authentication is found in lines 40-50 in column 3 of Claus. Final Office Action, p. 3. The Examiner contends that in this passage, Claus purportedly discloses, "providing a client communication device processor with secure access to a resource such as a vendor service." *Id.* However, this argument is not supported by Claus. In this regard, lines 30-40 in column 3 of Claus merely recite that multiple secret codes are stored within a smart card so that new secret codes can be derived at the authentication device by using a new master string. The cited paragraph fails to, however, provide a reason why the skilled artisan would have incorporated features into Claus' smart card to handle an unsolicited request, when the smart card controls when a challenge number (the purported "request") is received. As such, the Final Office Action fails to properly explain why one of skill in the art in possession of the cited references would have derived the claimed invention. Therefore, Applicant respectfully requests withdrawal of the § 103 rejection of claim 39.

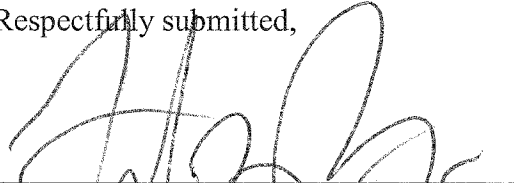
For similar reasons, Applicant respectfully submits that independent claims 43 and 47 overcome the § 103 rejections. In this regard, without modifying the smart card of Claus' system with Duda's security scheme, one of skill in the art would not have derived instructions to cause a processor-based system to receive an unsolicited request for a second computer system to provide an identification of the second computer system (claim 43); and likewise, one of skill in the art would not have derived the first computer of claim 47.

Dependent claims 40-42, 44-46 and 48-52 are patentable for at least the same reasons as the claims from which they depend.

CONCLUSION

In view of the foregoing, Applicant requests withdrawal of the § 103 rejections and a favorable action in the form a Notice of Allowance. The Commissioner is authorized to pay any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0160US).

Respectfully submitted,



Date: September 30, 2009

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